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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/008,179	12/07/2001	William Ford	450117-03683	4143
20999	7590	02/09/2004	EXAMINER	
FROMMER LAWRENCE & HAUG 745 FIFTH AVENUE- 10TH FL. NEW YORK, NY 10151			MARSCHEL, ARDIN H	
			ART UNIT	PAPER NUMBER
			1631	
DATE MAILED: 02/09/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/008,179	Applicant(s) FORD ET AL.	
	Examiner Ardin Marschel	Art Unit 1631	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9, 30 and 31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 30, and 31 is/are rejected.
- 7) ☒ Claim(s) 31 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Applicants' arguments, filed 11/17/03, have been fully considered but they are not deemed to be persuasive. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

NEW MATTER

Claim 6 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 6 has been amended regarding alkylating agents such that said agents are selected from a listed metal comprising a listed ligand but has been also amended to remove the limitation that such agents are complexes. This broadens the alkylating agent practice compared to the previous claim 6 as filed to include non-complexed combinations of a metal and ligand. Consideration of the instant disclosure as filed has failed to reveal a written description of such broader combinations without complexation character. This broadening without written basis therefore adds NEW MATTER. This rejection is necessitated by amendment.

NOT FURTHER LIMITING CLAIM OBJECTION

Claim 31 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claim 31 cites a "metallointercalator" which broadens the intercalating agent options compared to claim 3. The claim 3 limitation set forth as "aromatic ligands", for example, may be a metallointercalator, but non-aromatic ligand types of metallointercalators are options in claim 31 which is broader in scope. This objection is necessitated by amendment.

VAGUENESS AND INDEFINITENESS

Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The rejection of claim 5 is maintained and reiterated from the previous office action, mailed 8/12/03, due to the continued presence of the vague and indefinite "derivatives" limitation in line 3. No specific argument has been set forth regarding this claim 5 issue. Clarification is requested via clearer claim wording.

PRIOR ART

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-9, 31, and 32 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Rombeck et al. [Inorganica Chimica Acta 273:31 (1998)].

This rejection is maintained and reiterated from the previous office action, mailed 8/12/03, and as necessitated by amendment regarding newly added claims. It is noted that the instant claims are directed to a linker molecule per se. Claim 1, for example, cites such a linker molecule as comprising two binding groups covalently connected via a spacer group. One of these binding groups is adapted to bind a nanoparticle, but there is no claim limitation which requires the presence of a bound nanoparticle. Therefore, the linker of Rombeck et al. still is deemed to support this rejection due to citing the linker molecule per se limitations as set forth in the previous office action, mailed 8/12/03, which have not been negated by amending of instant claim 1 nor any of the other instant claims as listed above. Claims 31 and 32 are included hereinunder due to limiting intercalating options within claim 3 but without requiring that any such intercalating agent is required in the claimed linker molecule per se thus including the alkylating agent limitation option from claim 2. Applicants argue that Rombeck et al. neither discloses nor enables a nanoparticle binding group or molecule. In response, Rombeck et al. discloses an amine as noted in said previous office action, mailed 8/12/03, which is exactly one of the instantly cited alkylating agents for nanoparticle

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binding as set forth in instant claims 8 and 9 which are embodiments of such a nanoparticle binding group due to their dependence from claim 1 thus anticipating instant claims 1 etc.

Claims 1-8, 31, and 32 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Beyer et al. [J. Med. Chem. 41:2701 (1998)].

This rejection is maintained and reiterated from the previous office action, mailed 8/12/03, and as necessitated by amendment regarding newly added claims. It is noted that the instant claims are directed to a linker molecule per se. Claim 1, for example, cites such a linker molecule as comprising two binding groups covalently connected via a spacer group. One of these binding groups is adapted to bind a nanoparticle, but there is no claim limitation which requires the presence of a bound nanoparticle. Therefore, the linker of Beyer et al. still is deemed to support this rejection due to citing the linker molecule per se limitations as set forth in the previous office action, mailed 8/12/03, which have not been negated by amending of instant claim 1 nor any of the other instant claims as listed above. Claims 31 and 32 are included hereinunder due to limiting intercalating options within claim 3 but without requiring that any such intercalating agent is required in the claimed linker molecule per se thus including the alkylating agent limitation option from claim 2. Applicants argue that Beyer et al. neither discloses nor enables a nanoparticle binding group or molecule. In response, Beyer et al. discloses a maleimide, as a type of carboxylic acid, as noted in said previous office action, mailed 8/12/03, which is exactly one of the instantly cited alkylating agents for nanoparticle binding as set forth in instant claim 8 which are embodiments of such a

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nanoparticle binding group due to their dependence from claim 1 thus anticipating instant claims 1 etc.

Claims 1, 31, and 32 are rejected under 35 U.S.C. 102(b) and (e)(2) as being clearly anticipated by Nilsen et al. (P/N 5,175,270).

This rejection is maintained and reiterated from the previous office action, mailed 8/12/03, and as necessitated by amendment regarding newly added claims. It is noted that the instant claims are directed to a linker molecule per se. Claim 1, for example, cites such a linker molecule as comprising two binding groups covalently connected via a spacer group. One of these binding groups is adapted to bind a nanoparticle, but there is no claim limitation which requires the presence of a bound nanoparticle. Therefore, the linker of Rombeck et al. still is deemed to support this rejection due to citing the linker molecule per se limitations as set forth in the previous office action, mailed 8/12/03, which have not been negated by amending of instant claim 1 nor any of the other instant claims as listed above. Claims 31 and 32 are included hereinunder due to limiting intercalating options within claim 1 but without requiring that any such intercalating agent is required in the claimed linker molecule per se thus including the generic nanoparticle binding group practice as in claim 1.

No claim is allowed.

Applicants' amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicants are reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the Central PTO Fax Center. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993)(See 37 CFR § 1.6(d)). The Central PTO Fax Center number is (703) 872-9306.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ardin Marschel, Ph.D., whose telephone number is (571)272-0718. The examiner can normally be reached on Monday-Friday from 8 A.M. to 4 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, Ph.D., can be reached on (571)272-0722.

Any inquiry of a general nature or relating to the status of this application should be directed to Legal Instrument Examiner, Tina Plunkett, whose telephone number is (571)272-0549 or to the Technical Center receptionist whose telephone number is (703) 308-0196.

February 4, 2004

Ardin H. Marschel
ARDIN H. MARSCHEL
PRIMARY EXAMINER